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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,230	10/13/2000	Sylvia Braselmann	ONYX1027-DIV1	1176

7590 12/18/2001  
Gregory Giotta Ph D  
Vice President and Chief Legal Counsel  
ONYX Pharmaceuticals Inc  
3031 Research Drive  
Richmond, CA 94806

EXAMINER

TUNG, PETER P

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/687,230

Applicant(s)

Brasermann

Examiner

Peter Tung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Sep 28, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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### **DETAILED ACTION**

1. Claims 8-12 are pending.

#### ***Specification***

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reason(s): the sequence on page 9, line 27 is not identified by a SEQ ID NO:.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 8-11 are indefinite as they are directed to a protein of a specified sequence but refer to the protein as "protein(s)." It is unclear whether the protein(s) are a group of different proteins, of which one is that of the specified sequence. Alternatively, if "protein(s)" is referring to those proteins which comprise the specified sequence, "protein(s)" should be replaced with "protein" as

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it is recognized that "protein" would encompass other proteins which comprise the specified sequence.

6. Claim 8 is indefinite as the claim is drawn to a protein "encoded an amino acid sequence comprising SEQ ID NO: 2 or SEQ ID NO: 1." SEQ ID NO: 2 is an amino acid sequence so the instant protein would comprise the amino acid sequence of SEQ ID NO: 2. SEQ ID NO: 1 is a polynucleotide sequence so the instant protein would be encoded by the polynucleotide sequence of SEQ ID NO: 1.

7. Claim 9 is indefinite as the protein of claim 8 does not further comprise a bromodomain as the bromodomain is already present in SEQ ID NO: 2. This rejection may be overcome by replacing "which further comprises a bromodomain comprising" with "wherein a bromodomain comprises." It is also noted that the "or" before SEQ ID NO: 2 should be replaced with "of."

8. Claim 10 is indefinite as it refers to the amino acid sequence "shown in SEQ ID NO: 2" and the cDNA "shown in SEQ ID NO: 1." By the use of "shown in," the metes and bounds of the claim are unclear. This rejection may be overcome by replacing "shown in" with "as set forth in."

9. Claim 12 is indefinite because it depends upon an indefinite base claim and fails to correct the problem.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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11. Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated phosphatidylinositol-3' kinase associated protein comprising the amino acid sequence of SEQ ID NO: 2 or encoded by SEQ ID NO: 1, does not reasonably provide enablement for any phosphatidylinositol-3' kinase associated protein that binds to the intermediate SH2 domain on the regulatory subunit of phosphatidylinositol-3' kinase. This rejection is explained in the previous Office action.

12. Applicants argue that the instant rejection is overcome by the amended claims, dependent upon specific SEQ ID NOs.

13. Applicant's arguments filed 9/28/01 have been fully considered but they are not persuasive. While the amended claims address parts of the previous rejection by limiting the protein to a specific SEQ ID NO:, as amended, the use of "protein(s)" does not limit the instant claims to only a protein comprising the specific SEQ ID NOS: but also to an undisclosed protein complex where a protein comprising the specified SEQ ID NO: is only a subunit of a larger complex. It is noted that this rejection may be overcome by replacing "protein(s)" with "protein" and that the use of "protein" in the instant claim would encompass any phosphatidylinositol-3' kinase associated proteins comprising SEQ ID NO: 2 or encoded by SEQ ID NO: 1.

***Allowable Subject Matter***

14. Claims 8-12 are allowable over the prior art of record. The prior art of record does not teach or suggest a protein comprising SEQ ID NO: 2 or encoded by a cDNA of SEQ ID NO: 1.

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*Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Pach', is positioned above the printed name.

PONNATHAPACHUT MURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600